

## REMARKS

Claims 9 and 11 are cancelled herein without prejudice or disclaimer.

Claims 5-8, 10, and 12 are pending. Reconsideration is requested.

### ENTRY OF AMENDMENT UNDER 37 CFR §1.116

Applicant requests entry of this Rule 116 Response because it is believed that the cancellation of claims 9 and 11 puts this application into condition for allowance and should not entail any further search by the Examiner since no new features are being added and no new issues are being raised.

### ITEM 2: OBJECTION TO DRAWINGS

In item 2 of the Office Action, the Examiner objects to the drawings and contends that the "drawing (FIG. 1) received on 12/15/05 . . . should be resubmitted and labeled as a 'Replacement Sheet.'" (Action at page 2).

Applicant respectfully points out to the Examiner that the Amendment filed December 15, 2005 included a FIG. 1 sheet correctly labeled as a "Replacement Sheet" (in addition to the "Annotated Sheet"). Further, the USPTO Patent Application Information Retrieval (PAIR) system Image File Wrapper correctly reflects the same.

A copy of the USPTO PAIR printout showing that FIG. 1 was correctly labeled as "Replacement Sheet," as filed, is attached for the convenience of the Examiner.

Withdrawal of the objection to the drawings is requested.

### ITEMS 5-7: REJECTION TO CLAIMS 5-8, 10, AND 12

In item 5 of the Office Action, the Examiner rejects independent claims 5, 10, and 12 (and dependent claim 6) under 35 U.S.C. §103(a) as being unpatentable over Joao (U.S.P. 6,347,302) in view of Solomon et al (U.S.P. 6,847,935). In items 6-7 of the Office Action, the Examiner rejects dependent claims 7-8 under 35 U.S.C. §103(a) as being unpatentable over Joao in view Solomon, Official Notice, and Lockwood (U.S.P. 4,567,359).

The rejections are traversed.

### Features Not Taught By Combination Of Art

As set forth in MPEP §2143.03 "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." Applicant submits that features recited by each of the independent claims are not taught by the cited art, alone or by an *arguendo* combination of the cited art.

For example, claim 5 recites a system for mediating between a user and a manufacturer where:

(1) "purchase information related to products possessed . . . is stored;" and

(2a) "an identifier of a product and (2b) guarantee information related to said product are stored for each product available." (Emphasis added)

Claim 5, further recites that the system "requests insurance on said products according to said (1) purchase information . . . and (2a and 2b) information (identifier and guarantee information) (emphasis added)."

Claims 10 and 12 respectively recite a method and a computer-readable medium having a similar recitation of features.

In item 8b of the Office Action, entitled Response To Arguments, the Examiner contends:

the claim language does not clearly recite that the data in the two storage parts are complementary or that data lacking in one source is supplemented by data in the other.

However, Applicant points out to the Examiner that the claim language clearly recite that data in both storages are complementary.

Applicant submits that even an *arguendo* combination of the art does not teach a system, method or computer-readable medium including a request for insurance based on both the (1) purchase information and the (2b) guarantee information for a specifically (2a) identified product. Since recited features are not taught by the cited art, the rejection should be withdrawn.

#### **No Motivation To Combine The Art**

The Action concedes that Joao does not teach "a second storage component with an identifier and guarantee related information from at least one manufacturer for each product to be insured." However, the Examiner contends it would have been obvious to modify Joao with the teaching of Solomon:

to capture a more exhaustive list of information, providing a greater opportunity for data mining. . . . and to allow the information in the one source to "verify" the information in the second source.

(Action at page 4).

However, as set forth in MPEP §2144. 04:

The mere fact that a worker in the art could rearrange the parts of the reference device . . . is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation . . . without the benefit of appellant's specification, to make the necessary changes in the reference device.

Applicant submits there is no motivation to combine the art in a manner as the Examiner

suggests.

Applicant points out that Solomon teaches (see for example, col. 2, lines 16-19) a system that merely:

also allows consumers to interactively submit information from a comfortable environment. Thus, consumers are more likely to provide a more exhaustive list of information, providing a greater opportunity for data mining.

(Emphasis added.)

Applicant respectfully point out to the Examiner, that as understood by one of ordinary skill in the art, "data mining" is defined, for example as:

a technique using software tools geared for the user who typically does not know exactly what to search for, but is looking for particular patterns or trends in large amounts of data.

(See, HUD's Glossary of Terms, at <http://www.hud.gov/cfo/glossary.html#D>)

Accordingly, Applicant submits the Examiner's logic in developing a proposed motivation for a combination of the cited art is not correct. Rather, Applicant respectfully submits that it is understood by those of ordinary skill in the art that a "data mining" would not have been used as a motivation for modifying a system for specific comparison of guarantee and product information and insurance quotes.

Applicant also submits that the Examiner's proposed motivation for combination of the cited art to "verify" the information in the second source is not correct.

Instead, as recited by claims 5, 10, and 12, both purchase and guarantee information are used as a basis for the insurance choice and not to "verify" the information in the second source, as the Examiner contends.

Since there is no motivation to combine the art, the rejection should be withdrawn.

### **Summary**

Since features recited by independent claims 5, 10, and 12 (and dependent claim 6-8) are not taught by the cited art, alone or in combination, and *prima facie* obviousness is not established, the rejection should be withdrawn and claims 5-8, 10, and 12 allowed.

### **CONCLUSION**

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

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